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Finnegan Henderson Farabow Garret & Dunner 1300 I Street NW Washington, DC 20005			PHAN, TAM T	
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			2144	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/868,730

**Applicant(s)**

KIM, YONG-TAE

**Examiner**

Tam (Jenny) Phan

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2002.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-27 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 01 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/21/2000.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This application has been examined. Pre-amendment received on 07/01/2002 has been entered.
2. Claims 1-27 are presented for examination.

#### ***Priority***

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Republic Of Korea on 06/01/2000. It is noted, however, that applicant has not filed a certified copy of the 2000-30109 application as required by 35 U.S.C. 119(b).
4. The effective filing date for the subject matter defined in the pending claims which has support in parent 2000-30109 in this application is 06/01/2000. Any new subject matter defined in the claims not previously disclosed in parent 2000-30109, is entitled to the effective filing date of 07/01/2002.

#### ***Information Disclosure Statement***

5. An initialed and dated copy of Applicant's IDS form 1449, received on 06/21/2000, is attached to the instant Office action.

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Maeda (EP 0898410), which reference was identified in the international search report.

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8. Regarding claim 1, Maeda disclosed a method for writing a picture mail by using a network, comprising the steps of: receiving a text message from a user terminal; receiving a selected picture list from among a plurality of predetermined picture lists from said user terminal; retrieving a plurality of pictures from a storage device, corresponding to the selected picture list; transmitting the retrieved pictures to said user terminal; receiving a selected picture from said user terminal; and generating a picture mail out of the text message by inserting the selected picture (Title, Abstract, column 1 lines 5-7, column 3 lines 21-38).

9. Regarding claim 2, Maeda disclosed a method further comprising the steps of: retrieving a predetermined letter string in the text message; and converting the letter string into a predetermined picture to thereby generate an advertisement (column 5 lines 26-52).

10. Regarding claim 3, Maeda disclosed a method further comprising the step of receiving a position where the picture is inserted (column 3 lines 44-49).

11. Regarding claim 4, Maeda disclosed a method further comprising the step of receiving a completion notice of writing the text message from the user terminal (column 7 lines 31-40).

12. Regarding claim 5, Maeda disclosed a method wherein said network is at least one selected from the group of a wired communication network and a wireless communication network (Figure 1, column 4 lines 18-33).

13. Regarding claim 6, Maeda disclosed a method wherein said user terminal is at least one selected from the group of a personal computer and a mobile communication terminal (Figure 1, column 4 lines 18-33).

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14. Regarding claim 7, Maeda disclosed a method for registering picture that is used in a picture mail, comprising the steps of: receiving a designated letter string from a user terminal by using a network; receiving a selected picture corresponding to the designated letter string from said user terminal; and storing link data between the designated letter string and the selected picture (column 4 lines 6-17, column 5 lines 26-36, column 8 lines 16-26).

15. Regarding claim 8, Maeda disclosed a method wherein the selected picture is stored in at least one selected from the group of a storage device included in said user terminal and a storage device included in a server (Figure 1, column 3 lines 31-38, column 4 lines 6-17).

16. Regarding claim 9, Maeda disclosed a method wherein said network is at least one selected from the group of a wired communication network and a wireless communication network (Figure 1, column 4 lines 18-33).

17. Regarding claim 10, Maeda disclosed a method wherein said user terminal is at least one selected from the group of a personal computer and a mobile communication terminal (Figure 1, column 4 lines 18-33).

18. Regarding claim 11, Maeda disclosed a method for writing a picture mail by using a network, comprising the steps of: receiving a text message from a user terminal; receiving a converting request for converting the text message into a picture mail from said user terminal; successively retrieving a predetermined letter string included in the text message according to a predetermined manner corresponding to the converting request; successively transmitting a plurality of pictures corresponding to the letter string to said user terminal; successively receiving a selected picture among the

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plurality of pictures from said user terminal; converting the letter string into the selected picture corresponded to the letter string; and transmitting the picture mail comprising the selected picture to said user terminal (Title, Abstract, column 1 lines 5-7, column 3 lines 21-38, column 4 lines 6-17, column 5 lines 26-36, column 8 lines 16-26).

19. Regarding claims 12-13, the apparatus for writing a picture mail by using a network corresponds directly to the method for writing a picture mail by using a network of claims 1 and 4, and thus these claims are rejected using the same rationale.

20. Regarding claims 14 and 20, the apparatus for registering a picture corresponds directly to the method for registering a picture of claim 7, and thus these claims are rejected using the same rationale.

21. Regarding claims 15 and 21, the apparatus for writing a picture mail by using a network corresponds directly to the method for writing a picture mail by using a network of claim 11, and thus these claims are rejected using the same rationale.

22. Regarding claims 16-19, the apparatus for writing a picture mail by using a network corresponds directly to the method for writing picture mail of claims 1-4, and thus these claims are rejected using the same rationale.

23. Regarding claims 22-24, the computer readable medium having stored thereon computer-executable instructions corresponds directly to the method for writing picture mail of claims 1-3, and thus these claims are rejected using the same rationale.

24. Regarding claim 25, the computer readable medium having stored thereon computer-executable instructions corresponds directly to the method for registering picture that is used in a picture mail of claim 7, and thus is rejected using the same rationale.

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25. Regarding claim 26, the computer readable medium having stored thereon computer-executable instructions corresponds directly to the method for writing a picture mail of claim 11, and thus these claims are rejected using the same rationale.

26. Since all the limitations of the claimed invention were disclosed by Maeda, claims 1-26 are rejected.

27. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

28. Claims 1, 3-6, 12-13, 16, 18-19, 22, and 24 is rejected under 35 U.S.C. 102(e) as being anticipated by Lloyd et al. (U.S. Patent Number 6,779,178), hereinafter referred to as Lloyd.

29. Regarding claim 1, Lloyd disclosed a method for writing a picture mail by using a network, comprising the steps of: receiving a text message from a user terminal (Figure 1); receiving a selected picture list from among a plurality of predetermined picture lists from said user terminal (Figure 1, Abstract, column 2 lines 10-23); retrieving a plurality of pictures from a storage device, corresponding to the selected picture list (column 2 lines 42-47, column 12 lines 26-48); transmitting the retrieved pictures to said user terminal (Figure 1); receiving a selected picture from said user terminal (Figure 1, column 21 lines 33-41); and generating a picture mail out of the text message by

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inserting the selected picture (Figure 1, Abstract, column 1 lines 46-58, column 2 lines 10-23).

30. Regarding claim 3, Lloyd disclosed a method further comprising the step of receiving a position where the picture is inserted (column 20 lines 39-64).

31. Regarding claim 4, Lloyd disclosed a method further comprising the step of receiving a completion notice of writing the text message from the user terminal (column 21 lines 32-41).

32. Regarding claim 5, Lloyd disclosed a method wherein said network is at least one selected from the group of a wired communication network and a wireless communication network (Figure 2, column 26 lines 28-54).

33. Regarding claim 6, Lloyd disclosed a method wherein said user terminal is at least one selected from the group of a personal computer and a mobile communication terminal (Figures 1 and 3, column 8 lines 60-65).

34. Regarding claims 12-13, the apparatus for writing a picture mail by using a network corresponds directly to the method for writing a picture mail by using a network of claims 1 and 4, and thus these claims are rejected using the same rationale.

35. Regarding claims 16 and 18-19, the apparatus for writing a picture mail by using a network corresponds directly to the method for writing picture mail of claims 1 and 3-4, and thus these claims are rejected using the same rationale.

36. Regarding claims 22 and 24, the computer readable medium having stored thereon computer-executable instructions corresponds directly to the method for writing picture mail of claims 1 and 3, and thus these claims are rejected using the same rationale.



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37. Since all the limitations of the claimed invention were disclosed by Lloyd, claims 1, 3-6, 12-13, 16, 18-19, 22, and 24 are rejected.

38. Claim 27 is rejected under 35 U.S.C. 102(e) as being anticipated by Kuwabara (U.S. Patent Number 6,665,548).

39. Regarding claim 27, Kuwabara disclosed a method for generating sound, comprising the steps of: detecting an approaching signal within a predetermined area, the approaching signal being generated from an input means coupled to a user terminal and the center position of the predetermined area of a picture; retrieving a predetermined sound corresponding to the picture based on the approaching signal; and generating the retrieved sound (Abstract, Figure 4, column 1 lines 21-37, column 1 lines 55-64, column 3 lines 12-29).

40. Since all the limitations of the claimed invention were disclosed by Kuwabara, claim 27 is rejected.

41. Claim 27 is rejected under 35 U.S.C. 102(e) as being anticipated by Isaacs et al. (U.S. Patent Number 6,760,754), hereinafter referred to as Isaacs.

42. Regarding claim 27, Isaacs disclosed a method for generating sound, comprising the steps of: detecting an approaching signal within a predetermined area, the approaching signal being generated from an input means coupled to a user terminal and the center position of the predetermined area of a picture; retrieving a predetermined sound corresponding to the picture based on the approaching signal;

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and generating the retrieved sound (Title, Abstract, Figures 1, 2-4, column 5 lines 35-56, column 5 line 62-column 6 line 22).

43. Since all the limitations of the claimed invention were disclosed by Issacs, claim 27 is rejected.

***Claim Rejections - 35 USC § 103***

44. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

45. Claims 2, 7-11, 14-15, 17, 20-21, 23, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lloyd et al. (U.S. Patent Number 6,779,178), hereinafter referred to as Lloyd, in view of Fein et al. (U.S. Patent Number 5,940,847), hereinafter referred to as Fein.

46. Regarding claim 2, Lloyd disclosed a method for writing a picture mail by using a network, comprising the steps of: receiving a text message from a user terminal (Figure 1); receiving a selected picture list from among a plurality of predetermined picture lists from said user terminal (Figure 1, Abstract, column 2 lines 10-23); retrieving a plurality of pictures from a storage device, corresponding to the selected picture list (column 2 lines 42-47, column 12 lines 26-48); transmitting the retrieved pictures to said user terminal (Figure 1); receiving a selected picture from said user terminal (Figure 1, column 21 lines 33-41); and generating a picture mail out of the text message by

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inserting the selected picture (Figure 1, Abstract, column 1 lines 46-58, column 2 lines 10-23).

47. Lloyd taught the invention substantially as claimed. However, Lloyd did not expressly teach a method further comprising the steps of: retrieving a predetermined letter string in the text message; and converting the letter string into a predetermined picture to thereby generate an advertisement.

48. Lloyd suggested exploration of art and/or provided a reason to modify the method for writing a picture email with additional formatting features (column 28 lines 20-6-28).

49. Fein disclosed a method further comprising the steps of: retrieving a predetermined letter string in the text message; and converting the letter string into a predetermined picture to thereby generate a visual presentation (column 1 lines 19-28, column 10 lines 6-33).

50. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Lloyd with the teachings of Fein to include the conversion of text string into predetermined symbol [picture] in order to automatically insert symbols [pictures] that would otherwise would require several key strokes or point-and-click commands (column 9 line 56-column 10 line 5).

51. Regarding claim 7, Lloyd and Fein combined disclose a method for registering picture that is used in a picture mail (Lloyd, Figure 1, column 20 lines 39-64), comprising the steps of: receiving a designated letter string from a user terminal by using a network (Fein, column 9 line 62-column 10 line 26); receiving a selected symbol [picture] corresponding to the designated letter string from said user terminal (Fein, column 9 line

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62-column 10 line 26); and storing link data between the designated letter string and the selected picture (Lloyd, column 15 lines 56-65, column 20 lines 39-64).

52. Regarding claim 8, Lloyd disclosed a method wherein the selected picture is stored in at least one selected from the group of a storage device included in said user terminal and a storage device included in a server (Figure 2, column 9 lines 2-13, column 15 lines 56-65).

53. Regarding claim 9, Lloyd disclosed a method wherein said network is at least one selected from the group of a wired communication network and a wireless communication network (Figure 2, column 26 lines 28-54).

54. Regarding claim 10, Lloyd disclosed a method wherein said user terminal is at least one selected from the group of a personal computer and a mobile communication terminal (Figures 1 and 3, column 8 lines 60-65).

55. Regarding claim 11, Lloyd and Fein combined disclose a method for writing a picture mail by using a network, comprising the steps of: receiving a text message from a user terminal (Lloyd, Figure 1); receiving a converting request for converting the text message into a picture mail from said user terminal (Lloyd, Figure 1, Abstract, column 2 lines 10-23); successively retrieving a predetermined letter string included in the text message according to a predetermined manner corresponding to the converting request (Fein, column 9 line 62-column 10 line 26); successively transmitting a plurality of pictures corresponding to the letter string to said user terminal (Fein, column 9 line 62-column 10 line 26); successively receiving a selected picture among the plurality of pictures from said user terminal (Lloyd, column 2 lines 42-47, column 12 lines 26-48); converting the letter string into the selected picture corresponded to the letter string; and

transmitting the picture mail comprising the selected picture to said user terminal (Lloyd, Figure 1, column 21 lines 33-41).

56. Regarding claims 14 and 20, the apparatus for registering a picture corresponds directly to the method for registering a picture of claim 7, and thus these claims are rejected using the same rationale.

57. Regarding claims 15 and 21, the apparatus for writing a picture mail by using a network corresponds directly to the method for writing a picture mail by using a network of claim 11, and thus these claims are rejected using the same rationale.

58. Regarding claim 17, the apparatus for writing a picture mail by using a network corresponds directly to the method for writing picture mail of claim 2, and thus is rejected using the same rationale.

59. Regarding claim 23, the computer readable medium having stored thereon computer-executable instructions corresponds directly to the method for writing picture mail of claim 2, and thus is rejected using the same rationale.

60. Regarding claim 25, the computer readable medium having stored thereon computer-executable instructions corresponds directly to the method for registering picture that is used in a picture mail of claim 7, and thus is rejected using the same rationale.

61. Regarding claim 26, the computer readable medium having stored thereon computer-executable instructions corresponds directly to the method for writing a picture mail of claim 11, and thus these claims are rejected using the same rationale.

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62. Since all the limitations of the claimed invention were disclosed by the combination of Lloyd and Fein, claims 2, 7-11, 14-15, 17, 20-21, 23, and 25-26 are rejected.

### ***Conclusion***

63. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Fujii (U.S. Patent Number 6,253,2312) titled "System and method for incorporating image data into electronic mail documents" disclosed a system and method for incorporating image data into electronic mail documents, comprising an image input device to generate image data, a processor to manipulate the image data, a text input module to receive text data, and a display module to combine the image data with the text data. The invention also includes a graphic conversion module to convert the image data into graphic data format, an e-mail conversion module to convert the graphic data and text data into an e-mail document, and means for sending the e-mail document to the Internet.

b. Ko (U.S. Patent Number 6,430,314) titled "Method and apparatus for entering data strings including hangul (Korean) and ASCII characters" disclosed methods for entering and editing data strings that are inputted into cellular telephones having a screen.

c. Ouyang (U.S Patent Number 6,674,372) titled "Chinese character input method using numeric keys and apparatus thereof" disclosed a method for inputting Chinese character using numeric keys, comprises allocating all phonetic symbols of the Chinese language on the numeric keys, setting a dictionary for

storing phonetic symbols together with single Chinese characters or words corresponding thereto, inputting a key signal from numeric keys by user's operation, retrieving a phonetic symbol or a tone symbol corresponding to the input key signal, obtaining a phonetic symbol or tone symbol from the retrieved symbol in accordance with a combination rule of the number of operations and phonetic symbols of the Chinese language, verifying whether the obtained symbol is a phonetic symbol or a tone symbol, converting phonetic symbol string which has been input to a corresponding single Chinese character or word with reference to the dictionary and then outputting to a display when the retrieved symbol is a tone symbol.

64. Refer to the enclosed PTO-892 for details and complete listing of other pertinent prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (571) 272-3930. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on (571) 272-3925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William Cuchlinski

SPE

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December 8, 2004